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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,431	12/30/2003	David B. Rhoades	RPS920030167US2	8088

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EXAMINER	
YANCHUS III, PAUL B	

ART UNIT	PAPER NUMBER
2116	

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/748,431	RHOADES, DAVID B.	
	Examiner	Art Unit	
	Paul B. Yanchus	2116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-11* is/are rejected.

7)☒ Claim(s) *3* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/2/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Boesch, US Patent Application Publication no. 2003/0018746.

Regarding claim 1, Boesch discloses a method for customizing a computer system, comprising the steps of:

receiving a customer order, wherein the customer order specifies customization information for a computer system [paragraphs 0015-0018];

sending a computer system to the customer [paragraph 0016], the computer system including a network port through which configuration parameters corresponding to the customization information specified in the customer order can be received [paragraph 0043], and a configuration mechanism for storing the configuration parameters received via the network port [inherent that some sort of memory or mechanism must be used to store the parameters when they are downloaded, paragraphs 0046 and 0047], the computer system being adapted to customize the computer system according to the configuration parameters stored in the configuration mechanism [paragraphs 0043 and 0044];

providing instructions to the customer to connect the network port of the computer system to a network [paragraph 0041]; and

transmitting the customization parameters over the network and to the network port of the computer system for storage in the configuration mechanism [paragraphs 0043 and 0044].

Regarding claim 2, Boesch further discloses providing instructions to the customer to initiate a boot process [paragraph 0043];

wherein, in response to the initiation of a boot process, the computer system customizes an operating system according to the configuration parameters stored in the configuration mechanism [paragraphs 0043 and 0044].

Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Paul, US Patent no. 5,991, 875.

Paul discloses a method for customizing a computer system comprising:

(a) providing a configuration mechanism [configuration card] in the computer system [column 4, lines 1-6];

(b) transmitting customization information for the computer system to the configuration mechanism [column 3, lines 37-45]; and

(c) retrieving the customization information in the configuration mechanism by the computer system to customize the computer system [column 3, lines 28-35 and column 4, lines 20-25].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, US Patent no. 5,991, 875, in view of Cepulis, US Patent no. 6,961,791.

Regarding claims 5 and 6, Paul, as described above, discloses a configuration mechanism, which is configured to be plugged into a computer system, that stores customization information for the computer system. Paul does not disclose that the configuration mechanism is a PCI adapter. However, as shown by Cepulis, PCI adapters for storing configuration information for a computer system are well known in the art [column 2, lines 28-33 and column 3, lines 55-67]. It would have been obvious to one of ordinary skill in the art to implement the Paul configuration mechanism as a well known PCI adapter to increase the compatibility of the system. One of ordinary skill in the art would be motivated to implement the Paul configuration mechanism as a well known PCI adapter to increase the compatibility of the system by enabling the configuration mechanism to be used with any computer systems that include the well known PCI bus architecture.

Regarding claim 7, Paul discloses that the configuration mechanism includes at least one communication port [communications interface, column 3, lines 37-41].

Regarding claim 8, Paul and Cepulis are silent as to how the customization information is downloaded to the configuration mechanism. However, in order for the configuration information to be stored on the card the configuration information must be downloaded to the configuration mechanism from some sort of server device. Therefore, the configuration information in the Paul and Cepulis system is inherently downloaded from a server to the configuration mechanism via a communication port.

Regarding claims 9 and 10, Paul and Cepulis, as described above, disclose that information is downloaded from a server to the configuration mechanism via a communication port. Paul and Cepulis do not disclose that the communication port is an Ethernet port coupled to a LAN and does not disclose that the server is coupled to the LAN. However, Examiner takes official notice that communication between servers and clients using Ethernet ports and a LAN is widely used and is certainly well known in the art. It would have been obvious to one of ordinary skill in the art to modify the Paul and Cepulis system to use a conventional Ethernet port and LAN as a means for communication between the configuration mechanism and the server.

Regarding claim 11, Paul discloses performing a first system boot and querying the configuration mechanism for the customization information [column 4, lines 41-54].

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4-8 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-8, 10, 11 and 13 of copending Application No. 10/748,898. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 4-8 and 11 of the present application include the limitation, providing a configuration mechanism in the computer system. Claims 6-8, 10, 11 and 13 of copending Application No. 10/748, 898 disclose coupling the configuration mechanism to the computer system. Since the configuration mechanism in Claims 6-8, 10, 11 and 13 of copending Application No. 10/748, 898 is coupled to the computer system it is also part of the system. Therefore, claims 6-8, 10, 11 and 13 of copending Application No. 10/748, 898 teach all of the limitations of claims 4-8 and 11 of the present application.

Claims 4-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4 and 5 of copending Application No. 10/748,937. Although the conflicting claims are not identical, they are not patentably distinct from each other. The preamble in claims 1, 2, 4 and 5 of copending Application No. 10/748,937

recite a system for customizing a computer system and claims 4-8 of the present application recite a method for customizing a computer system. However, claims 1, 2, 4 and 5 of copending Application No. 10/748,937 teach all of the limitations of claims 4-8 of the present application.

Claims 4-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-11 of copending Application No. 10/748,630. Although the conflicting claims are not identical, they are not patentably distinct from each other. The preamble in claims 6-11 of copending Application No. 10/748,630 recite a system for customizing a computer system and claims 4-10 of the present application recite a method for customizing a computer system. However, claims 6-11 of copending Application No. 10/748,937 teach all of the limitations of claims 4-10 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

O'Connor, US Patent no. RE38,762, discloses a process for configuring software in a build-to-order system.

Garnett, US Patent no. 6,851,614, discloses a portable programmable data carrier for storing configuration information.

Herzi et al., US Patent no. 6,353,885, discloses a method for providing configuration information to a computer system.

Li et al., US Patent no. 6,012,088, discloses configuring a computer system at a customer site.

Simpson et al., US Patent no. 5,404,580, discloses a removable memory means for storing user specific configuration information for a computer device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Yanchus whose telephone number is (571) 272-3678. The examiner can normally be reached on Mon-Thurs 8:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on (571) 272-3670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Yanchus
April 27, 2006

THUAN N. DU
PRIMARY EXAMINER